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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88458681
Applicant	OptConnect Management, LLC
Applied for Mark	OPTCONNECT MANAGED WIRELESS SOLUTIONS
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Submission	Applicant's brief
Attachments	OPTCONNECT MANAGED WIRELESS SOLUTIONS Appeal Brief.pdf(163877 bytes)
Appealed classes	<p>Class 009. First Use: 2009/10/00 First Use In Commerce: 2009/10/00 All goods and services in the class are appealed, namely: Machine-to-machine (M2M) device networking products, namely, modems, network routers, computer network adaptors, network power controllers, antennae, and amplifiers designed to facilitate machine-to-machine communications with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; computer hardware for running firmware or software designed to facilitate machine-to-machine (M2M) communications and interfaces with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; microcontrollers and remote control transmitters designed for internet of things (IoT) enabled remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; downloadable software designed for connecting, operating and managing machine to machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment</p> <p>Class 038. First Use: 2009/10/00 First Use In Commerce: 2009/10/00 All goods and services in the class are appealed, namely: Providing machine-to-machine (M2M) connectivity over long distances and remote locations with unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing electronic transmission of data and information to wirelessly connected machine-to-machine (M2M), network-connected, and Internet connected remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment comprising the Internet of things (IOT); technical consulting in the field of electronic and digital data transmission and communication via machine to machine (m2m) technology, remote device management and the internet of things (IoT) related to unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment</p>

	<p>Class 042. First Use: 2009/10/00 First Use In Commerce: 2009/10/00</p> <p>All goods and services in the class are appealed, namely: Providing on-line non-downloadable software designed for connecting, operating and managing machine to machine (m2m) services for remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing a web portal featuring technological information and technology to monitor and manage connectivity, usage, management, and provisioning of machine-to-machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment, and to provide reporting data and diagnostics and monitor the location of such devices; providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet</p>
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of OptConnect Management, LLC

Application Serial No. 88/458,681

Trademark: OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design

Filing Date: June 4, 2019

APPLICANT'S APPEAL BRIEF

This is an appeal by OptConnect Management, LLC (“OptConnect”) from a final refusal to register the mark OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design in connection with the following goods and services:

- **Class 9**: Machine-to-machine (M2M) device networking products, namely, modems, network routers, computer network adaptors, network power controllers, antennae, and amplifiers designed to facilitate machine-to-machine communications with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; computer hardware for running firmware or software designed to facilitate machine-to-machine (M2M) communications and interfaces with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; microcontrollers and remote control transmitters designed for internet of things (IoT) enabled remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; downloadable software designed for connecting, operating and managing machine to machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment.
- **Class 38**: Providing machine-to-machine (M2M) connectivity over long distances and remote locations with unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing electronic transmission of data and information to wirelessly connected machine-to-machine (M2M), network-connected, and Internet connected remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment comprising the Internet of things (IOT); technical consulting in the field of electronic and digital data transmission and communication via machine to machine (m2m) technology, remote device management and the internet of things (IoT) related to unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment.
- **Class 42**: Providing on-line non-downloadable software designed for connecting, operating and managing machine to machine (m2m) services for remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing a web portal featuring technological information and technology to monitor and manage connectivity, usage, management, and provisioning of machine-to-machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale

devices, and agricultural equipment, and to provide reporting data and diagnostics and monitor the location of such devices; providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet.

Registration was refused under Section 2(d) of the Lanham Act on the grounds of a likelihood of confusion with the mark OPCONNECT, registered by Opconnect, Inc. (“Opconnect”) for “Interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging” in Class 9 as Registration No. 3,914,101.

INTRODUCTION

OptConnect has used its OPTCONNECT house mark continuously since 2009 in connection with highly specialized machine-to-machine device networking products -- specifically, modems, network routers, computer network adaptors, network power controllers, antennae, amplifiers, microcontrollers, remote control transmitters, and computer software, and related services. OptConnect’s products are purchased to become components of, or work with, devices such as ATMs and vending machines. Its products enable those machines to engage in sophisticated communications with other devices. This is known as machine-to-machine networking or, relatedly, the “Internet of Things”. *See* March 4, 2020 Office Action Response (“3/4/20 Office Action Response”), Ex. B; October 2, 2020 Request for Reconsideration (“10/2/20 Request for Reconsideration”), Ex. E; February 16, 2021 Request for Reconsideration Following Amendment (“2/16/21 Request for Reconsideration”), Ex. A.

OptConnect’s products become the communication “brains” of automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment. For example, OptConnect’s

technology enables an ATM in a remote location to communicate with the bank's central facility, or a vending machine to communicate with supply chain headquarters. OptConnect does not build or sell the ATM or the vending machine, or figure out how it dispenses money, candy, or soft drinks. For example, OptConnect produces the technology that is used in or in connection with the machine and enables the machine to "talk" with computers and other devices. *Id.*

OptConnect's goods are not "one-size-fits-all" products that can be used for all different applications and in all different settings. Rather, OptConnect produces seven different types of routers, designed for different applications, with different upload/download speeds (low, medium, and high), different carriers (Verizon or AT&T), and suitability for different use environments. Almost all come with specification sheets with dozens of characteristics and are specified to be used with only particular applications (e.g., ATMs, commercial laundries, smart vending devices). *See* 2/16/21 Request for Reconsideration, Ex. A. OptConnect has limited its identification of goods and services to only these specific intended applications.

It is obvious from OptConnect's identification of goods that its products are not consumer products. OptConnect's purchasers are (i) companies that develop and operate devices that incorporate OptConnect's products and (ii) sophisticated technical professionals at the businesses that use the end devices (e.g., ATM and cash automation system operators and developers and technical professionals at banks). *See* 3/4/2020 Office Action Response, Ex. B; 10/2/20 Request for Reconsideration, Ex. E; 2/16/21 Request for Reconsideration, Ex. B.

In response to the office actions refusing registration, OptConnect submitted hundreds of pages of evidence demonstrating that confusion is unlikely for multiple reasons:

(1) the goods and services defined in OptConnect's application and Opconnect's registration have different, non-overlapping functionality -- a difference which OptConnect has

highlighted by limiting its identification to only those specific applications for which OptConnect's goods are used;

(2) both parties' customers are sophisticated purchasers who exercise special care in making purchasing decisions and are unlikely to associate one party's mark with the other;

(3) the parties' respective products travel in different trade channels to different consumers -- the same entities do not offer both OptConnect's components for facilitating M2M device communications and Opconnect's finished EV charging kiosks;

(4) the cited registration does not cover any services, and there is no overlap between OptConnect's Class 38 and 42 services and Opconnects's Class 9 EV charging kiosks;

(5) the parties' marks are clearly distinguishable, given the additional wording MANAGED WIRELESS SOLUTIONS in OptConnect's mark and that the prefixes OP- (suggesting "operation") and OPT- (suggesting "optimal" or "option") create different commercial impressions, and the Trademark Office has recognized this difference by allowing multiple OP/OPT marks to coexist on the federal register for computer software;

(6) Opconnect's CONNECT-formative mark is not particularly distinctive for vehicle charging kiosks and services and is therefore entitled to only a narrow scope of protection; and

(7) the cited registration issued in 2011, with the registrant claiming first use in 2010, and was recently renewed, so the parties' marks have coexisted in the marketplace for a decade without any evidence of actual confusion.

The office actions did not rebut OptConnect's arguments and evidence. The Examining Attorney continually pointed to the purported relatedness of the parties' goods, but offered no analysis of the functionalities of the parties' respective goods or of their respective customers or trade channels. Moreover, as detailed below, the Examining Attorney's evidence consisted of an

assortment of internet printouts from a wide range of third-party websites relating in some manner to the electric vehicle or IoT solutions fields, but provided no specific details to show an overlap of functionality, customers, or marketing channels.

The Examining Attorney began by submitting internet printouts of websites of companies in the IoT or electric vehicle fields in a purported attempt to establish that the same entity commonly provides and markets both parties' goods under the same mark. However, he failed to show a single company that sells both electric charging kiosks and M2M and IoT communication products or services. While he showed some businesses producing some type of electric vehicle charging product and referencing how their products have M2M communication capability, none of the highlighted businesses sell the hardware or software that affords that capability. *See* September 4, 2019 Office Action, April 2, 2020 Office Action ("4/2/20 Office Action"), and 3/4/20 Office Action Response.

After OptConnect submitted an abundance of evidence to rebut the Examining Attorney's premise, the Examining Attorney asserted that "even if the evidence did not show that the same entities offer the same goods and services, consumer confusion is still likely because the goods and services of the parties are used in a complementary fashion; that is, applicant's goods constitute at least components of registrant's goods", and therefore consumers might believe that the parties' goods come from the same source. *See* November 12, 2020 Reconsideration Letter. The Examining Attorney then submitted printouts from websites of (i) M2M technology companies and (ii) EV charging companies, showing that the former's technology is often incorporated into the latter's EV charging products.

The term "complementary" is frequently used to refer to goods that would be bought by the same consumer and used together (e.g., tennis racquets and tennis balls, burgers and burger

buns, pencils and notebooks). This is not the case with OptConnect's M2M device components and Opconnect's finished kiosks. To state that these products are complementary is the equivalent of stating that plastic and toys are "complementary" goods and therefore likely to be believed by consumers to emanate from the same source, simply because one can be a component of the other. Moreover, a wide range of disparate modern goods -- from household goods to office appliances -- are "connected" to the Internet of Things, so to accept the Examining Attorney's proposition would be to accept that IoT technology components are complementary to all of these goods, a premise that is preposterous considering that the groups of goods are sold to different consumers, for different purposes, at different levels of the supply chain. Indeed, the Examining Attorney offers no case law or marketplace evidence to support his argument that OptConnect's and Opconnect's goods would be considered "complementary" for purposes of finding a likelihood of confusion. Indeed the sole case that he cites in his discussion of this proposition -- *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) -- actually affirmed the Board's dismissal of opposer's likelihood-of-confusion claim, noting that there was "nothing in the record to suggest" that a purchaser of the applicant's goods who also purchases the opposer's goods would consider the goods to emanate from the same source. See T.M.E.P. § 1207.01(a)(1).

In sum, the Examining Attorney's evidence fails to support his assertions that the two parties' goods are offered by the same parties or are complementary in nature. Two different products are related under Section 2(d) if they share similar functionality, customers, and marketing channels, such that those shared customers could mistakenly think that they came from the same source. Charging kiosks and M2M devices do not share functionality, customers, or marketing channels, because one is a finished product that charges vehicles, the other is a

component of other devices. They are sold to different customers for different purposes – and the Examining Attorney has failed to introduce any evidence to the contrary.

Accordingly, and for the reasons set forth in more detail below, OptConnect respectfully submits that there is no likelihood of confusion and asks that its application be approved for publication.

ARGUMENT

A. The Goods and Services Defined in OptConnect’s Application and Opconnect’s Registration Have Different Functionalities and Are Not Sold by the Same Parties

As detailed above, OptConnect produces highly specialized machine-to-machine device networking products that become components of other devices. The identification of goods specifies that these other devices are automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment. Its products enable these devices to engage in sophisticated machine-to-machine communications. OptConnect’s products are purchased by product engineers at companies that develop and operate devices that incorporate OptConnect’s products, and by technical professionals at the banking, laundry, vending, and agricultural businesses that use the end devices.

In contrast, Opconnect produces a finished product – an interactive kiosk – ready to be placed in a parking lot to charge electric cars. The components of the kiosk – defined in the registration as “computers, computer hardware, computer peripherals, and computer operating software” – are already in the kiosk, and the finished kiosk is purchased from Opconnect by managers of electric vehicle fleets, and property managers and service stations that furnish chargers to drivers who park on their premises.

The parties' respective products have entirely different functionalities, and are used in entirely different locations by entirely different purchasers. The same company would not produce both goods because they serve require entirely different technologies and perform entirely different functions. The Examining Attorney has submitted not one piece of evidence to the contrary, despite his assertions.

B. The Parties' Goods Are Sold Through Different Trade Channels to Different Consumers

OptConnect sells its products to the companies that develop and operate devices that incorporate OptConnect's products and to the technical professionals at the businesses that use the end devices:

- ATM and cash automation system operators and developers and technical professionals at banks (for automated teller machines and cash automation systems)
- Developers and operators of technology for commercial laundry operators and technical professionals at commercial laundries (for commercial laundry equipment)
- Vending machine developers and operators (for vending machines and self-service retail point-of-sale devices)
- Developers and operators of connected farm equipment and technical professionals at farms (for agricultural equipment).

OptConnect has submitted case studies and customer testimonials from its website documenting what categories of customers would purchase the goods and services identified in its application. *See* 3/4/2020 Office Action Response, Ex. B; 10/2/20 Request for Reconsideration, Ex. E; 2/16/21 Request for Reconsideration, Ex. B.

By contrast, Opconnect sells its electronic vehicle charging systems to professionals who manage vehicle fleets, to service stations that want to offer charging, and to property managers

responsible for parking lots at office buildings, apartments, condo complexes, parking lots, and other locations where drivers park their vehicles. OptConnect has submitted evidence from Opconnect's website, and from the websites of six other EV charging kiosk producers, documenting who these customers are. *See* 3/4/2020 Office Action Response, Ex. A; 10/2/20 Request for Reconsideration, Ex. D; 2/16/21 Request for Reconsideration, Ex. C.

The parties' products are not consumer goods that are sold in retail stores or directly purchased from retail websites. Rather, OptConnect's M2M-facilitating device components are sophisticated products that are sold to product engineers and technical professionals who contact OptConnect after visiting OptConnect's website or receiving a personal recommendation. Opconnect's EV charging kiosks are similarly sold to fleet managers, property managers, and other individuals who personally contact Opconnect. Accordingly, there is virtually zero chance of overlap between the parties' trade channels.

Confusion cannot occur if there is no overlap between Opconnect's and OptConnect's customers, and one party's customers would never encounter the other party's products in the marketplace. The two companies operate in different customer universes – Opconnect's EV charging kiosks would not be offered for sale to OptConnect's customers, or vice versa. Each universe of customers would never encounter the other party's mark.

Given the separate customer markets, there is no overlap in marketing channels. Each company's goods are, by definition, business-to-business goods, and would therefore be sold through marketing channels aimed at those specific business users. Parking garage operators would read trade magazines and attend trade shows aimed at their industry. Entirely different trade press and trade shows are directed at technical professionals responsible for ATM systems or responsible for outfitting retail checkout counters. Opconnect's customers would not

encounter OptConnect's advertisements, promotional materials, or sales force, and vice versa. They would have no opportunity to be confused.

C. The Purchasers of Both Parties' Products Are Sophisticated Consumers Who Exercise Significant Care When Making Purchasing Decisions

In evaluating the potential for confusion, "[purchaser] sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Elec. Design & Sales v. Elec. Data Sys.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992). Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. T.M.E.P. § 1207.01(d)(vii).

With OptConnect's goods and services, purchaser sophistication and care is an absolutely influential factor. As detailed above, OptConnect's customers are (i) sophisticated technology companies who incorporate OptConnect's products into their ATMs, vending machines, or other remote-location devices, and (ii) technical professionals at businesses who are vitally concerned about M2M communication with their devices in the field. If you are designing and operating ATMs for banks, you pay extremely close attention to the third-party technology products that you select for incorporation into those ATMs, given that they are critical to the functioning of your devices. And if you are a technical professional at a bank with a remote machine full of cash, you want to make absolutely sure that your ATM is able to communicate with bank headquarters at all times and properly dispense the right amount of cash to customers. Faulty communication can result in lost revenue or an unsatisfactory and unreliable customer experience. M2M device networking devices are not one-size-fits-all products – a customer would contact OptConnect and work with the company to determine the optimal technology solution for that customer's specific project.

Opconnect's EV vehicle charging kiosks are purchased by professionals who manage vehicle fleets, to service stations that want to offer charging, and to property managers responsible for parking lots at office buildings, apartments, condo complexes, parking lots, and other locations where drivers park their vehicles. *See* 3/4/2020 Office Action Response, Ex. A; 10/2/20 Request for Reconsideration, Ex. D; 2/16/21 Request for Reconsideration, Ex. C. These individuals also must contact Opconnect directly in order to purchase Opconnect's kiosks. Opconnect's kiosks are presumably quite expensive and a fleet manager or property manager presumably plans to outfit its business with EV charging kiosks only once, rendering such purchasing decisions extremely significant.

In light of the foregoing, it is clear that the circumstances of consumers' purchases of both parties' products are "circumstances suggesting care in purchasing [that] minimize the likelihood of confusion" under T.M.E.P. § 1207.01(d)(vii).

D. There is No Overlap Between Opconnect's Goods and OptConnect's Services

The Examining Attorney's arguments and evidence relate almost entirely to OptConnect's Class 9 goods, and not its Class 38 and 42 services. The foregoing analysis of functionality, customer markets, and marketing channels applies equally to OptConnect's Class 38 connectivity, data transmission, and related technical consulting services, and Class 42 software, web portal, and remote management services. The Examining Attorney has failed to meet the Office's burden of showing a likelihood of confusion between Opconnect's Class 9 goods and OptConnect's Class 38 and 42 services, and the refusal with respect to these services should unquestionably be reversed.

E. The Parties' Marks are Distinguishable, Due to the Additional Matter in OptConnect's Mark and the Very Different Commercial Impressions Created by the Prefixes OPT- and OP-

In addition to the term OPTCONNECT, OptConnect's mark also includes the wording MANAGED WIRELESS SOLUTIONS and a unique design element. The Examining Attorney dismissed this additional matter, asserting that "[b]ecause the wording MANAGED WIRELESS SOLUTIONS is disclaimed as descriptive, it is less significant in terms of comparing the two marks" and that OptConnect's distinctive design element "does not obviate the mark's overall similarity to the registered mark." *See* 4/2/20 Office Action.

However, while the wording MANAGED WIRELESS SOLUTIONS is disclaimed, it has meaning and significance in communicating the source of the services. "Managed Wireless Solutions" directly references OptConnect's machine-to-machine wireless connectivity solutions, and unmistakably tells the public that OptConnect uses its mark to help businesses connect devices to each other and to the Internet of Things. In contrast, the wording MANAGED WIRELESS SOLUTIONS has no applicability to Opconnect's electric vehicle charging kiosks. Thus, someone encountering the OPTCONNECT MANAGED WIRELESS SOLUTIONS logo mark would not assume that a company with that logo has any connection with Opconnect's business.

There is no evidence that the public encounters any business with the wording MANAGED WIRELESS SOLUTIONS providing Opconnect's goods, so the presence of that wording is an influential factor in avoiding confusion. The wording MANAGED WIRELESS SOLUTIONS is unique to OptConnect on the federal register and while the wording WIRELESS SOLUTIONS appears in seventeen other active federal marks, none of those applications or

registrations covers any goods or services that reference “kiosks” or “electric vehicles.” 10/2/20 Request for Reconsideration, Ex. C.

Per T.M.E.P. 1207.01(b)(iii), “Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if...the marks in their entirety convey significantly different commercial impressions.” Here, the parties’ marks do not even share an identical term, in light of the differences between OPTCONNECT and OPCONNECT; when one then considers the addition of MANAGED WIRELESS SOLUTIONS and a distinctive design element to OptConnect’s mark, it becomes clear that OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design conveys a significantly different commercial impression in the context of OptConnect’s goods and services, making confusion unlikely.

Moreover, as detailed in OptConnect’s earlier responses, the prefixes OPT- and OP- create very different commercial impressions. OP- is most commonly an abbreviation for “operation.” OPT- is not short for “operation”, and in the context of OptConnect’s products (which come in multiple varieties for different uses) suggests either “optimal” or “option.” The Trademark Office has recognized this difference by allowing multiple OP/OPT marks to coexist on the federal register for computer software. *See* 3/4/2020 Office Action Response, Ex. C; 10/2/20 Request for Reconsideration, Ex. B. Thus, one cannot treat the marks as if they are identical. Each creates a different commercial impression which is sufficient to distinguish the two marks from each other, given the additional matter in OptConnect’s mark as well as the differences between the parties’ goods, the parties’ non-overlapping consumers, and the other factors detailed in this brief and in OptConnect’s earlier responses.

F. Opconnect’s Mark is Not Entitled to a Broad Scope of Protection

The TMEP is clear that “[i]f the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” TMEP § 1207.01(d)(iii) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005)).

Here, OptConnect has introduced evidence demonstrating that Opconnect is entitled to only a narrow scope of protection, because of the existence of multiple third-party uses and registrations of or pending applications for CONNECT-formative marks for vehicle charging kiosks and services. *See* 2/16/21 Request for Reconsideration, Ex. D. These include the following:

- WE CONNECT allowed intent-to-use application in Classes 9, 12, 35, and 42 by Volkswagen AG (Serial No. 88/733,198);
- SEMACONNECT and SEMACONNECT & Design registered in Class 9 by SemaConnect, Inc. (Reg. No. 4,182,151 and Reg. No. 4,327,474);
- NISSANCONNECT registered in Classes 9, 35, 37, 38, 39, 42, and 45 by Nissan Jidosha Kabushiki Kaisha (Reg. No. 4,951,536);
- EVCONNECT & Design registered in Classes 9, 37, and 42 by EV Connect, Inc. (Reg. No. 4,759,043 and Reg. No. 4,754,786 and Reg. No. 4,767,544); and
- CAR-CONNECT & Design pending International Registration designation in Classes 9, 37, and 39 by CAR-connect GMBH (Serial No. 79/298,524).

Id.

OptConnect also introduced evidence that all of the above CONNECT-formative marks coexist not just on the trademark register, but also in the marketplace. *Id.*

Because of the weakness of the term CONNECT- in Opconnect's mark, Opconnect is not entitled to the broad protection that the Examining Attorney has provided. Moreover, the weakness of the word CONNECT means that the public is likely to focus on the prefix OP- in the registrant's mark – which, as detailed below, creates a different commercial impression from the prefix OPT-, such that the parties' marks themselves create very different commercial impressions.

G. OptConnect's and Opconnect's Goods Have Coexisted in the Marketplace for Over a Decade Without Confusion

OptConnect's application asserts an October 2009 date of first use in commerce, and Opconnect claims first use in May 2010. Both businesses have been well-publicized during that time. *See* 10/2/20 Request for Reconsideration, Ex. F. OptConnect is not aware of a single instance of actual consumer confusion between the two companies, further supporting that no likelihood of consumer confusion exists. The fact that two marks have been used in the U.S. market for many years without any evidence of actual confusion weighs against a finding of likelihood of confusion. *See In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

CONCLUSION

For the foregoing reasons, OptConnect respectfully requests that the Examining Attorney's refusal of Application Serial No. 88/458,681 be reversed and the Application approved for publication.

Dated: April 30, 2021

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